

Chadwick, et al.
U.S. Application No. 09/905,589

REMARKS

Claims 19-26 and 28-29 are pending in the application.

The Outstanding Rejections

The Examiner rejected claims 19-26 and 28-29 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,476,211 B1 (herein referred to as the '211 patent).

The Examiner also rejected claims 19-26 and 28-29 under 35 U.S.C. §112, first paragraph as allegedly containing subject matter not described in the specification.

Patentability Arguments

1. 35 U.S.C. §102(e) Rejection

Applicants respectfully traverse and submit that the claimed invention of CD39L2 antibodies and the subject matter disclosed in the '211 patent were subject to obligation of assignment to Hyseq, Inc. (now Nuvelo, Inc.) at the time of filing the instant application. Both the '211 patent and the parent application of the instant application, U.S. Patent No. 6,350,447, were subsequently assigned to Hyseq, Inc. (Reel/Frame: 012324/0862 and 01374/0667, respectively). As such, the disclosed but not claimed subject matter in the '211 patent should not preclude patentability of the CD39L2 antibodies of the instant application. Therefore, in light of the aforementioned remarks, the rejection under 35 U.S.C. §102(e) is moot and should be withdrawn. Furthermore, as requested by the Examiner in the Final Office Action mailed June 15, 2004, Applicants herein submit a copy of the Rule 1.132 declaration of Walter Funk, Ph.D. dated July 28, 2004 (herein referred to as the Funk Declaration) regarding common assignment of the instant invention and the '211 patent.

2. 35 U.S.C. §112, first paragraph Rejection

Applicants have withdrawn the amendment of Claim 19 from the previous responses of March 29, 2004 and March 8, 2004. Claim 19 is now directed to a CD39L2 antibody that specifically binds to a polypeptide of SEQ ID NO: 2; therefore the rejection under 35 U.S.C. §112, first paragraph should be withdrawn.

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CONCLUSION

On the basis of the foregoing amendments and remarks, Applicants respectfully submit that the pending claims are in condition for allowance, and a Notice of Allowance is respectfully requested as soon as possible. If there are any questions regarding these amendments and remarks, or if further discussion would expedite allowance of the claims, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

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